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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,061	01/04/2002	Cristina Comelli	'13170PCTUS	5944

7590

02/06/2004

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EXAMINER

RAYMOND, RICHARD L

ART UNIT

PAPER NUMBER

1624

DATE MAILED: 02/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/030,061	<b>Applicant(s)</b> COMELLI ET AL.	
	<b>Examiner</b> Richard L. Raymond	<b>Art Unit</b> 1624	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 14 November 2003.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) 10, 13 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11, 12, 14-23 and 25-27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.  
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3/24/03.                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. It is requested that a status paragraph referring to the fact that the present application is a 371 application be added as the first paragraph of the specification.

### ***Election/Restrictions***

2. In view of applicants' amendment of claim 18, the requirement for restriction of record is herein withdrawn.
3. In response to the requirement for election of species, applicants have elected the compound of Example 6: N-[2-[(ethoxycarbonylmethyl)aminocarbonyl]oxyethyl] hexadecanamide, a compound where  $R_1$  is hexadecanyl;  $R_2$  is H; and  $R_3$  is formula (IV) wherein Y is  $\text{CH}_2\text{CH}_2$  and X is Formula (VI) wherein  $R_{13}$  is H and  $R_{12}$  is  $\text{CH}_2\text{C}(\text{O})\text{OEt}$ . Claims 1-9, 11, 12, 14-23 and 24-27 are readable thereon. Claims 10, 13 and 24, which limit the X and  $\text{NR}_{12}\text{R}_{13}$  groups to exclude the groups of the elected species, stand withdrawn from further consideration as not being readable on the elected species.

### ***Improper Markush Rejection***

4. Claims 1-9, 11, 12, 14-23 and 25-27 are rejected as being improper Markush claims in the definition of the  $R_1$  and  $R_3$  variables. So substituted, the resulting total compounds lack a common core and are structurally diverse and patentably distinct one

from the others. A reference anticipating one under 35 USC 102 would not be a reference against the others under 35 USC 103. Further, an undue search burden is involved in the U.S. classification and STN/CAS search. Note the diverse functional groups in the  $R_1$  and  $R_3$  definitions. Limitation of the claims to compounds where  $R_1$  is an alkyl group and X in  $R_3$  is formula (VI) wherein  $R_{12}$  is a carboxy-substituted alkyl group, encompassing the elected species, will overcome this rejection

#### ***Claim Objections***

5. Claims 2-8, 11-17, 20-22, 25 and 27 are objected to because of the following informalities: The R variables should contain subscripts, and in claim 25, "wherein" is misspelled, in claim 16, "comprising" is misspelled and in claim 17, "compound" is misspelled. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 112***

6. Claim 18 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. This product claim is a substantial duplicate of claim 1 upon which it is dependent. Statements of intended use do not normally patentably distinguish product claims.

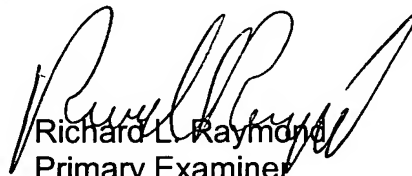
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard L. Raymond whose telephone number is (703) 308-4523. The examiner can normally be reached on Monday-Thursday (9:30AM-8:00PM)).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mukund J. Shah can be reached on 305-4716. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.



Richard L. Raymond  
Primary Examiner  
Art Unit 1624

rr  
February 4, 2004